

REMARKS

[0002] Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1-36 are presently pending. Claims 1, 2, 14, 23 and 30 are amended herein. No claims are withdrawn or cancelled herein. No new claims are added herein.

Statement of Substance of Interview

[0003] The Examiner graciously talked with me—the undersigned representative for the Applicant—on September 9, 2008. Applicant greatly appreciates the Examiner's willingness to talk. Such willingness is invaluable to both of us in our common goal of an expedited prosecution of this patent application.

[0004] During the interview, I discussed how the claims differed from the cited references, namely Challapali, BigBlueBall, Copeland, Ultimate Metal Forum, Easter Egg Archive, and Sector #101. Without conceding the propriety of the rejections and in the interest of expediting prosecution, I also proposed several possible clarifying amendments.

[0005] I understood the Examiner to tentatively concur that the § 102 rejections and the objection to specification would be withdrawn. However, the Examiner indicated that he would need to review the cited art more carefully or do another search, and requested that the proposed amendments be presented in writing.

[0006] Applicant herein amends the claims in the manner discussed during the interview. Accordingly, Applicant submits that the pending claims are allowable over the cited art of record for at least the reasons discussed during the interview.

Formal Request for an Interview

[0007] If the Examiner's reply to this communication is anything other than allowance of all pending claims, then I formally request an interview with the Examiner. I encourage the Examiner to call me—the undersigned representative for the Applicant—so that we can talk about this matter so as to resolve any outstanding issues quickly and efficiently over the phone.

[0008] Please contact me to schedule a date and time for a telephone interview that is most convenient for both of us. While email works great for me, I welcome your call as well. My contact information may be found on the last page of this response.

Claim Amendments

[0009] Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicant amends claims 1, 2, 14, 23 and 30 herein. Applicant amends claims to clarify claimed features. Such amendments are made to expedite prosecution and more quickly identify allowable subject matter. Such amendments are merely intended to clarify the claimed features, and should not be construed as further limiting the claimed invention in response to the cited references.

Formal Matters

[0010] The Examiner objects to the specification for lack of antecedent basis for the claimed subject matter in claim 23. Herein, Applicant amends claim 23, as shown above, to correct the informalities noted by the Examiner.

Substantive Matters

Claim Rejections under § 102 and § 103

[0011] The Examiner rejects claims 1-2, 4, 6-7, 11-12, 14, 21, 23-25, 30-31, 33 and 35-36 under § 102. For the reasons set forth below, the Examiner has not shown that the cited references anticipate the rejected claims.

[0012] In addition, the Examiner rejects claims 3, 5, 7, 8-10, 13, 15-16, 17, 18, 19, 20, 22, 26, 27, 28-29, 32, 34 under § 103. For the reasons set forth below, the Examiner has not made a prima facie case showing that the rejected claims are obvious.

[0013] Accordingly, Applicant respectfully requests that the § 102 and § 103 rejections be withdrawn and the case be passed along to issuance.

[0014] The Examiner's rejections are based upon the following references alone or in combination:

- **Big Blue Ball:** *Big Blue Ball*, Trillian Emoticons; 8/7/02; BigBlueBall.com;
- **Copeland:** *Copeland*, E-mail's signature smiley face is long in the tooth; September 20, 2002; Pittsburg Tribune Review.

- **Ultimate Metal Forum:** *Ultimate Metal Forum*, Smiley Emoticons; September 5th, 2002; UltimateMetal.com
- **Aaron of Borg:** *Aaron of Borg (The Easter Egg Archive)*; Yahoo Messenger 5.5 hidden smileys; 10/10/02: The Easter Egg Archive;
- **Sector #101:** *Sector #101*, Yahoo Messenger Emoticons; 8/28/02; Sector #101;
- **Challapali:** *Challapali*, US Patent Publication No. 2002/0194006 (Published December 19, 2002);
- **AllAlias.com:** *AllAlias.com*, MUST READ:Signature/Avatar Rules, Updated 5-25-03; 9/6/03; AllAlias.com
- **Chodor:** *Chodor, et al.*, US Patent Publication No. 2002/0036990 (Published March 28, 2002);
- **Hickman:** *Hickman, et al.*, US Patent No. 7,013,327 (issued March 14, 2006);
- **Dawson:** *Dawson*, US Patent No. 6,252,588 (issued June 26, 2001);
- **Day:** *Day, et al.*, US Patent Publication No. 2005/0027839 (Published February 3, 2005);
- **Jilk, JR.:** *Jilk, JR., et al.*, US Patent Publication No. 2002/0010746 (Published January 24, 2002);
- **Goodwin, III:** *Goodwin, III, et al.*, US Patent Publication No. 2002/0065931 (Published May 30, 2002);
- **Goldschneider:** *Goldschneider, et al.*, US Patent Publication No. 2002/0107925 (Published August 8, 2002);

- **Huntington:** *Huntington, et al.*, US Patent Publication No. 2003/0131098 (Published July 10, 2003); and
- **Zhao:** *Zhao*, US Patent No. 7,353,253 (issued April 1, 2008).

Anticipation Rejections

[0015] Applicant submits that the anticipation rejections are not valid because, for each rejected claim, no single reference discloses each and every element of that rejected claim.¹ Furthermore, the elements disclosed in the single reference are not arranged in the manner recited by each rejected claim.²

Based upon Big Blue Ball, Copeland, Ultimate Metal Forum, Easter Egg Archive, Sector #101, or Challapali

Independent Claim 1

[0016] The Examiner rejects claim 1 under 35 U.S.C. § 102(b) as being anticipated by BigBlueBall, Copeland, Ultimate Metal Forum, Easter Egg Archive, Sector #101, or Challapali. Applicant respectfully traverses the rejection of this claim. Based on the reasons given below, Applicant asks the Examiner to withdraw the rejection of this claim.

[0017] Applicant submits that the cited references do not anticipate or make obvious at least the following features as recited in this claim (with emphasis added):

- **creating an emoticon by a sender** by selecting pixels to be used as an emoticon;

¹ "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); also see MPEP §2131.

² See *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

- **assigning** a character sequence to the pixels **by the sender**;
- wherein the emoticon is to be **substituted for the character sequence within the text message**;
- establishing a **real-time peer-to-peer** link between the sender and the destination to retrieve the pixels from a storage medium associated with the sender.

[0018] In contrast, the references (BigBlueBall, Copeland, Ultimate Metal Forum, Easter Egg Archive, Sector #101) are not directed to custom emoticons. In all of these cited references, the senders do not create emoicons (represented by pixels) and assign character sequences to the emoticons. Furthermore, in Easter Egg Archive, the emoticon is not substituted for the character sequence within the text message.

[0019] Also, Challapali is relied upon by the Examiner in the rejection of this claim. However, Challapali is directed to a **text to visual speech** technology (see Title of Challapali), where a user receives a video speech broadcast containing the message (see Paragraph [0020] of Challapali). In Challapali, **the emoticon itself is converted into** a facial expression (see Abstract of Challapali), which is almost the opposite of the claimed feature of the Application, where the character sequence is substituted **into an emoticon within the text message**. Furthermore, as shown in the figures of Challapali, Challapali receives texts as commands to change the facial expression of **another** image, which is different from the claimed feature that the emoticon is to be **substituted for the character sequence within the text message**.

[0020] Consequently, either BigBlueBall, Copeland, Ultimate Metal Forum, Easter Egg Archive, Sector #101, or Challapali does not disclose all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

[0021] Furthermore, the Examiner agreed that, if nothing else, this portion of the amended claim was not disclosed in the cited art: "establishing a real-time peer-to-peer link between the sender and the destination to retrieve the pixels from a storage medium associated with the sender."

Based upon Challapali

[0022] The Examiner rejects claims 14, 21, 23 and 30 under 35 U.S.C. § 102(b) as being anticipated by Challapali. Applicant respectfully traverses the rejection of these claims. Based on the reasons given below, Applicant asks the Examiner to withdraw the rejection of these claims.

Independent Claim 14

[0023] Applicant submits that Challapali does not anticipate this claim because it does not disclose the following features as recited in this claim (with emphasis added):

- receiving a communication, wherein the communication includes a character sequence **in a text message**, wherein the character

sequence is mappable to a pixel array residing outside the communication;

- **replacing the character sequence within the text message** in the communication with the pixel array

[0024] As discussed above, Challapali is directed to a **text to visual speech** technology, where a user receives a video speech broadcast containing the message. In Challapali, **the emoticon itself is converted into** a facial expression, which is almost the opposite of the claimed feature of the Application, where the character sequence is substituted **into an emoticon within the text message**.

[0025] Consequently, Challapali does not disclose all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Independent Claim 21 (Previously Presented)

[0026] Applicant submits that Challapali does not anticipate this claim because it does not disclose the following features as recited in this claim (with emphasis added):

- a means for sending the graphics data of the emoticon **in a second communication** from the first communication;

- a means for **replacing the character sequence in the real-time first communication** with the graphics data from the second communication

[0027] As discussed above, Challapali is directed to a **text to visual speech** technology, where a user receives a video speech broadcast containing the message. In Challapali, **the emoticon itself is converted into** a facial expression, which is almost the opposite of the claimed feature of the Application, where the character sequence is substituted **into an emoticon within the text message**.

[0028] Consequently, Challapali does not disclose all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Independent Claim 23

[0029] Applicant submits that Challapali does not anticipate this claim because it does not disclose the following features as recited in this claim (with emphasis added):

- an image selector to create an emoticon from an image, wherein the emoticon is representable as pixels;
- a transmitter to send the character sequence in a text message to a destination, wherein the pixels **replace the character sequence within the text message at the destination**

[0030] As discussed above, Challapali is directed to a **text to visual speech** technology, where a user receives a video speech broadcast containing the message. In Challapali, **the emoticon itself is converted into** a facial expression, which is almost the opposite of the claimed feature of the Application, where the character sequence is substituted **into an emoticon within the text message**.

[0031] Consequently, Challapali does not disclose all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Independent Claim 30

[0032] In the Office Action dated 6/16/08, the Examiner states:

25. As to claim 30, the claim is rejected for reasons similar to claim 24 above.

[0033] However, claim 30 has additional claimed features not recited in claim 24, and the Examiner failed to address these claimed features in the Office Action.

[0034] The Application describes methods and devices for creating and transferring **custom** emoticons to allow a user to adopt an arbitrary image as an emoticon. For example, claim 30 recites (in part):

- **creating** an emoticon by selecting an image associated with the emoticon **by a sender;**
- representing the image as **pixels** for the emoticon;

- assigning a character sequence to the emoticon, wherein the character sequence is **assignable by the sender**;
- wherein the emoticon is to be **substituted for the character sequence within the text message**

Obviousness Rejections

Lack of *Prima Facie* Case of Obviousness (MPEP § 2142)

[0035] Applicant disagrees with the Examiner's obviousness rejections. Arguments presented herein point to various aspects of the record to demonstrate that all of the criteria set forth for making a prima facie case have not been met.

[0036] The Examiner rejects claims 3, 5, 7, 8-10, 13, 15-16, 17, 18, 19, 20, 22, 26, 27, 28-29, 32, 34 under § 103. These claims ultimately depend upon independent claims 1, 14, 21, 23 and 30. As discussed above, claims 1, 14, 21, 23 and 30 are allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons. Applicant requests that the Examiner withdraw the rejection of each dependent claim where its base claim is allowable.

Conclusion

[0037] All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the **Examiner is urged to contact me before issuing a subsequent Action.** Please call or email me at your convenience.

Respectfully Submitted,

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Representatives for Applicant

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